

432 F.3d 1368
432 F.3d 1368, 77 U.S.P.Q.2d 1321
(Cite as: 432 F.3d 1368)

claims.

Topical application of the Pereira emulsion results in scavenging oxygen-containing free radicals and neutralizing reactive oxidants, whether the skin is sunburned or not. Thus, the effect that underlies both the prevention and treatment of sunburn is present in all cases of topical application of the Pereira composition. For that reason, Pereira anticipates not only the skin disorder and sunburn prevention claims, but also the sunburn treatment claims, which are based on the same underlying chemical processes. To illustrate the point, if it were discovered that using a particular kind of knee brace that was long worn by athletes to provide stability and thus minimize the effect of ligament injuries would also facilitate the treatment of cartilage damage and protect against further cartilage damage, that subsequent discovery would not give rise to a patentable invention. Moreover, it surely would not be the case that the use of the brace to prevent cartilage damage would be anticipated, but the use of the brace to treat cartilage damage would not, on the ground that all knees are subject to cartilage damage, but only some knees already have it.

The majority illustrates its distinction between sunburn treatment and sunburn prevention with its own analogy, arguing that the prior use of a hat to prevent sunburn would not anticipate the use of a hat to treat sunburn. Yet this analogy is inapt because a hat prevents sunburn by a mechanism, i.e., shade, that does not treat sunburn. In contrast, the mechanism by which a knee brace minimizes the effects of ligament injury, i.e., enhanced stability, is the same mechanism that facilitates treatment of cartilage damage and also prevents further cartilage damage. The same is true here, where the same chemical process treats and prevents sunburned skin.

Furthermore, the majority's distinction between the sunburn prevention claims, which the majority invalidates, and the sunburn treatment claims, which the majority upholds, is inconsistent with its invalidation of all the asserted claims of the skin disorder patent. The majority distinguishes the sunburn treatment claims by focusing on the applicability of the skin damage patent to aging skin, and suggests that "all skin is a victim of [the natural aging process]." The

skin damage patent, however, addresses "[a] wide variety of skin diseases and skin conditions in which the skin has undergone some form of accelerated aging." Skin damage patent, col.1, ll. 26-28. Like sunburn, those diseases and conditions are not found in all persons. The majority's distinction appears to rest upon its assertion that "[s]kin sunburn is not analogous to skin surfaces generally." However, there appears to be *1386 no greater specificity in topical application to skin that is sunburned than there is in topical application to skin that is diseased or skin that has suffered from accelerated aging. Accordingly, I submit that the majority's distinction between the treatment claims and the prevention claims is not a satisfactory ground for decision in this case.

This court's decisions in *Rapaport v. Dement*, 254 F.3d 1053 (Fed.Cir.2001), and *MEHL/Biophile International Corp. v. Millgram*, 192 F.3d 1362 (Fed.Cir.1999), are not at odds with the district court's conclusion in this case. Each of those cases involved a prior art method that was directed at an objective different from the objective of the claimed invention. In *Rapaport*, the prior art was a method for treating anxiety by administering a certain dosage of a particular drug three times a day, while the invention was a method for treating sleep apnea by administering a larger dosage of the same drug at the time of sleep. In *MEHL/Biophile*, the prior art was a method of using a laser to remove tattoos by aligning the laser over the pigmented skin, while the claimed invention was a method of using a laser to remove hair by aligning the laser over hair follicles. Although in each case practicing the prior art method might sometimes have the effect that was the objective of the claimed invention, the court held in each case that practicing the prior art method would not inherently have that effect. Thus, even if the prior art method for tattoo removal were used on skin having hair, it would not anticipate the claimed method in *MEHL/Biophile* because the prior art method did not dictate that the laser be aligned with hair follicles. And even if the prior art treatment of anxiety were used on patients suffering from sleep apnea, it would not anticipate the claimed method in *Rapaport* because the timing of drug administration and the dosages employed in the two treatments were different.

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432 F.3d 1368, 77 U.S.P.Q.2d 1321
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In this case, by contrast, topical application of the Pereira composition to normal skin inherently produces the same chemical processes that underlie the sunburn prevention claims, including scavenging free-oxygen-containing radicals and neutralizing other reactive oxidants. Topical application of the Pereira composition to sunburned skin inherently produces the same processes, which also underlie the sunburn treatment claims. Because the chemical processes that have the effect of treating and preventing sunburn are inherent consequences of the normal use of the Pereira composition, Pereira anticipates all the claims of the sunburn patent, just as it anticipates all the claims of the skin disorder patent.

In substance, the sunburn patent simply selects particular ingredients from among the small class of ingredients identified in Pereira and identifies specific benefits falling within the broader characterization of benefits identified in Pereira. To hold that the treatment claims of the sunburn patent are not anticipated by Pereira is to permit an inventor to secure patent rights to an existing invention merely upon identifying an inherent benefit of the prior art that had not previously been specifically identified, but that falls within a broader class of benefits already identified in the prior art. Because that result is contrary to the law of inherent anticipation as I understand it, I respectfully dissent from the portion of the court's judgment relating to the treatment claims of the sunburn patent.

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432 F.3d 1368, 77 U.S.P.Q.2d 1321

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